

**REMARKS**

Claims 1-10 are all the claims pending in the application.

**I. Claim Rejections Under 35 U.S.C. § 112**

Claims 1-10 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses the rejection.

In the Office Action, the Examiner asserted that the following claim recitation is not supported by the originally filed specification:

wherein said selection means switches its selection from data in said second storage means to data in said first storage means at least at one frame which is closest to a frame which is at a timing when a special reproduction is required among the frames which are intra-frame re-encoded, and wherein the number of wholly intra-frame re-encoded frames included in the data selected from said re-encoded moving picture data is one

However, Applicant respectfully submits that the recitation is supported by the specification. A non-limiting example of such support is found at least at pages 17-18 of the originally filed specification. (See Specification, P. 17, Ln. 14 - P. 18, Ln. 11). In particular, in the discussion of an exemplary embodiment, the specification states that when “for example, there is a random access reproducing request”, (e.g., “special reproduction is required”), “the selector . . . reads only the I picture” (e.g., a frame which is intra-frame re-encoded), “closest to . . . a decoding start point”, (e.g., a “frame which is at a timing when a special reproduction is required”), and “reads the encoded data . . . from the second memory . . . for the remaining frames”, (e.g., the number of wholly intra-frame re-encoded frames included in the data selected

from said re-encoded moving picture data is one"). (See Specification, P. 17, Ln. 14 - P. 18, Ln. 11).

Accordingly, as the originally filed specification fully supported the above recited limitation of the claims, Applicant respectfully requests that the Examiner withdraw the rejection to claims 1-10.

## **II. Claim Rejections Under 35 U.S.C. §103**

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakamoto (US Pat. No. 5,887,110) and further in view of Allen (US Pat. No. 4,584,616). Applicant respectfully traverses the rejection.

In the Office Action, the Examiner conceded that Sakamoto failed to teach or suggest at least "said selection means switches its selection from data in said second storage means to data in said first storage means **at least at one frame which is closest to a frame which is at a timing when a special reproduction is required among the frames which are intra-frame re-encoded, and wherein the number of wholly intra-frame re-encoded frames included in the data selected from said re-encoded moving picture data is one**". (Office Action, P. 4-5). To make up for this conceded deficiency, the Examiner cited the teachings of Allen. However, Applicant respectfully submits that Allen fails to make up for this conceded deficiency and is non-analogous prior art.

Applicant respectfully submits that Allen fails to teach or suggest the above recited limitation of the claim. Allen, and in particular the section of Allen cited by the Examiner, deals with **implementing an improved arrangement for magnetically recording physical representations of information on a storage disk or tape medium** (i.e. improved format as

defined by Allen). (Allen, Col. 18, Lns. 33-40 and Col. 14, Lns. 54-68). Such a disclosure fails to teach or suggest anything regarding the selection between moving picture frames. As such, Allen clearly fails to teach or suggest “said selection means switches its selection from data in said second storage means to data in said first storage means at least at one frame which is closest to a frame which is at a timing when a special reproduction is required among the frames which are intra-frame re-encoded, and wherein the number of wholly intra-frame re-encoded frames included in the data selected from said re-encoded moving picture data is one.” Thus, Applicant respectfully submits that Allen fails to make up for the conceded deficiencies of Sakamoto.

Further, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness as Allen is nonanalogous art.

To qualify as “analogous prior art”, the reference must be a reference “which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.” (MPEP 2141.01(a)(I)).

The present application is directed to converting encoded moving picture data compression encoded by using inter-frame prediction into a form capable of being subjected to special reproduction. As such, in order to qualify as “analogous art” the reference must be one which would have logically commended itself to one working in the art of encoding and re-encoding moving pictures. However, it is clear that the Allen reference fails this test.

Applicant respectfully submits that Allen is not a reference that would have commended itself to one working in the art of encoding and re-encoding moving pictures. **Allen is directed to an improved arrangement for magnetically recording physical representations of**

**information on a storage disk medium.** (Allen, Col. 14, Lns. 54-68). Applicant respectfully submits that one of skill in the art of encoding and re-encoding moving pictures would not have looked to the art of storing physical representations of information on storage disk media. As such, Applicant respectfully submits that Allen is nonanalogous prior art.

Accordingly, Applicant respectfully submits that claims 1-4 would not have been obvious under 35 U.S.C. § 103(a) over Sakamoto in view of Allen, because the references, alone or in combination, do not teach or suggest all of the features and limitations of the claims. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1 and claims 2-4 at least by virtue of their dependency from claim 1.

Applicant further respectfully submits independent claims 5 and 9-10 are patentable over the cited combination for similar reasons. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 5 and 9-10 and claims 6-8 at least by virtue of their dependency from claim 5.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

**RESPONSE** UNDER 37 C.F.R. § 1.111  
U.S. Appln. No.: 09/987,246

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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**23373**

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